

REMARKS

Applicant has carefully reviewed the final office action mailed March 28, 2006 and offers the following remarks to accompany the above amendments.

Claims 1-5, 8-17, and 21-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abidi et al. (hereinafter "Abidi") in view of Schellinger et al. (hereinafter "Schellinger"). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

Claim 1 recites a control system adapted to initiate a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network using a temporary directory number. The Patent Office has admitted Abidi does not teach this element but asserts that Schellinger does by teaching a three way call, where the cellular leg of the three way call is the claimed temporary directory number. In its previous response, Applicant argued that Schellinger did not teach or suggest "using a temporary directory number." A temporary directory number is contrasted from a primary directory number of the PSTN in paragraph 0005 of the Specification as filed. Schellinger reveals that there is a three way call, but indicates that the user's cellular phone number is used in the three way call. Schellinger specifies that the cellular phone number is a normal directory number (see Schellinger, col. 6, lines 10-30). Therefore, Schellinger's cellular phone number is not, under any reasonable interpretation, a temporary directory number.

In response, the Examiner states that the landline number of Schellinger is the primary directory number of the claims and that the cellular directory number of Schellinger is the claimed temporary directory number (Final Office Action mailed March 28, 2006, p. 2). The Examiner adds that the cellular phone number is a temporary number used to connect the mobile

phone to the cellular phone system, temporary meaning that the cellular directory phone is used only when it travels outside the range of the cheaper and more reliable cordless region. This interpretation ignores the teachings of Schellinger, as well as the plain meaning of the claim language and the Specification of the present invention.

First of all, if the Examiner is reading the cellular phone number of Schellinger as the temporary directory number and the landline phone number as the primary directory number, then Schellinger does not teach "the mobile terminal associated with a primary directory number" as claimed in claim 1 since the landline phone number of Schellinger used in the three way call is associated with the cordless base unit and not the mobile terminal (Schellinger, col. 6, lines 26-46; col. 7, lines 59-65). The Examiner's interpretation ignores the fact that Schellinger teaches using the landline phone number of the cordless base unit as part of the three way call and not a primary directory number associated with the mobile terminal. Therefore, under the Examiner's interpretation, Schellinger does not teach or suggest "the mobile terminal associated with a primary directory number" as claimed in claim 1. Therefore, claim 1 is allowable.

In addition, Schellinger teaches that the user is available via both a cellular and a landline number and that the PCC 101 determines whether the user's cellular or landline number has call routing priority (Schellinger, col. 6, lines 10-21). Much of the specification of Schellinger following the passage above discusses both situations, i.e., where the user's cellular number has call routing priority, and where the user's landline number has call routing priority. It is clear from a reading of Schellinger in its entirety that these are considered equal options. This contradicts the Examiner's assertion that the cellular phone number is a temporary number used to connect the mobile phone to the cellular phone system, temporary meaning that the cellular directory phone is used only when it travels outside the range of the cheaper and more reliable cordless region. First of all, Schellinger shows that the cellular phone number is not used only when it travels outside the cordless region (e.g., the user can have calls routed to the cellular phone number first before transferring to a second system if the PCC is not located, see Schellinger, col. 6, lines 10-21). Second, it is also clear that Schellinger does not contemplate the cellular number to be used any less often than the landline number. (See Figs. 6-1, 6-2, 7-1, and 7-2 and col. 7, line 7 through col. 8, line 61). Therefore, the cellular number of Schellinger is no more "temporary" than the landline number of Schellinger. The interpretation that the cellular number of Schellinger is somehow "temporary" is not supported by the teachings of

Schellinger itself. Third, Schellinger plainly contemplates that the cellular phone number is a number assigned by the cellular provider (Schellinger, col. 1, lines 28-32). A number assigned by the cellular provider is different than a temporary directory number. Reading the cellular number of Schellinger to be the claimed temporary directory number is therefore contrary to the teachings of the Schellinger reference.

In addition, the plain meaning of the claim language is that a temporary directory number is used for the purpose of initiating a transfer of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network. The Specification as filed teaches that a temporary directory number is contrasted from a primary directory number of the PSTN (Specification, paragraph 0005). The temporary directory number of the present invention is assigned by the wireless switch or VLR when the mobile terminal is registering with the cellular access network and is obtained to initiate a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network (Specification, paragraphs 0029-0031 and 0035-0037). In contrast, the cellular phone number of Schellinger is assigned by the cellular provider and is not assigned by the wireless switch or VLR when the mobile terminal is registering with the cellular access network in order to initiate a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network. Thus, the plain meaning of the claims read in light of the Specification compels a finding that the cellular number of Schellinger is not the same as the claimed temporary directory number. Schellinger does not teach or suggest a control system adapted to "initiate a transition of the first call being connected to the mobile terminal through the wireline network via the local wireless interface to the first call being connected to the mobile terminal through the wireless network using a temporary directory number" as claimed in claim 1. Since Schellinger does not teach or suggest the element for which it is cited, and the Examiner has admitted Abidi does not teach this element, the combination does not teach or suggest each and every element, and therefore does not render claim 1 obvious.

In short, the references individually do not teach or suggest the temporary directory number recited in claim 1. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the Patent Office has not established obviousness.

Claim 22 recites, in relevant part, the same element regarding a temporary directory number. The Patent Office relies on the same passages of Schellinger for its rejection. As explained above, the combination of Abidi and Schellinger does not teach or suggest the temporary directory number, and the Patent Office has not established obviousness for claim 22.

Claims 2-5, 8-17, and 21 depend from claim 1 and are not obvious for at least the same reasons. Claims 23-35 depend from claim 22 and also are not obvious for at least the same reasons. Applicant requests withdrawal of the § 103(a) rejection of claims 1-5, 8-17, and 21-35 at this time.

Various dependent claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abidi and Schellinger in further view of additional references. Claim 6 was rejected 35 U.S.C. § 103(a) as being unpatentable over Abidi and Schellinger in further view of Thyssen. Claims 7, 20, and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abidi and Schellinger in further view of Bell. Claims 18, 19, 36, and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abidi and Schellinger in further view of Charney. Claim 39 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abidi and Schellinger in further view of Bartle. Applicant respectfully traverses. The standards for obviousness are set forth above.

In its previous response, Applicant argued that for each of these various combinations, the Patent Office had not properly supported the stated motivation to combine the references with actual evidence, as required by the Federal Circuit. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). In the Final Office Action mailed March 28, 2006, the Patent Office argues that a combination is proper when there is some teaching, suggestion, or motivation to combine found in the references themselves or in the knowledge generally available to one of ordinary skill in the art and cites to *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1998), and *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992). These citations ignore the more recent holding of the Federal Circuit in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). *Dembiczak* holds that although the

motivation may come from a range of sources, it does not diminish the requirement for actual evidence, and that the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." *Ibid.* For each of the proposed combinations, the Examiner has merely stated what the tertiary reference allegedly teaches and then states that to the Examiner, one skilled in the art, it is obvious that the use of what is disclosed in the tertiary reference would be used because of the stated motivation. (Final Office Action mailed March 28, 2006, pp. 2-5). This is merely a statement of what the references teach and a broad conclusory statement that it would be obvious to use the reference. This type of statement was held in *Dembiczak* to be inadequate evidence.

Moreover, to the extent that the Examiner is stating that the motivation would have been obvious to the Examiner, as one skilled in the art, this is improper because a statement that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art is not sufficient for prima facie obviousness. MPEP 2143.02; see also *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) (the level of skill in the art cannot be relied upon to provide the suggestion to combine references). In addition, it is not appropriate for the Examiner to reach conclusions based on his own understanding or experience, or based on his opinion of what would be basic knowledge, without evidentiary support. MPEP 2144.03. The Examiner has failed to provide evidentiary support for his statements that it would have been obvious to use the respective tertiary references because of the stated motivation.

Because the Examiner has failed to provide actual evidence to support the stated motivations to combine the various tertiary references, the motivations are improper. Since the motivations are improper, the combinations are improper. Since the combinations are improper, the rejections are improper, and the Patent Office has not established obviousness. Applicant requests withdrawal of the § 103(a) rejection of claims 6, 7, 18-20, and 36-39 on this basis.

Applicant further traverses the rejections of claims 6, 7, 18-20, and 36-39 because the proposed combinations do not show the temporary directory number as recited in independent claim 1. As explained above, Abidi and Schellinger do not teach or suggest this element. The Patent Office points to nothing in Thyssen, Bell, Charney, or Bartle that cures the deficiencies of the first two references. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest the claim element, the combination does not establish

obviousness, and claims 6, 7, 18-20, and 36-39 are allowable. Applicant requests withdrawal of the § 103(a) rejection of these claims on this basis as well.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant's representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

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